

**REMARKS**

Applicant has amended claims 1 and 5 of the application as well as paragraph [26] of the specification. The amendment to the specification does not add new matter to the application, but more clearly describes and defines that which is shown in the drawings, and particularly that which is shown in Figure 2 of the application. Additionally, Applicant has added new claims 6 through 16 to more clearly define Applicant's invention as described in the specification and in the drawings. Applicant has not added any new matter to the application through these amended and new claims.

**I. REJECTION OF CLAIMS 1, 2, 4, AND 5**

**A. LAGERWAY ET AL.**

Applicant respectfully traverses the Examiner's rejection of claims 1, 2, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over Lagerway et al., U.S. Patent No. 5,774,271, in view of Lehrer, U.S. Patent No. 6,604,847. Applicant's invention differs markedly from the invention described by the Lagerway reference in several aspects. First, as stated by the Examiner on page 2 of the Office Action, "Lagerway does not teach the use of the power source and the LED light source in the housing." On page 3 of the Office Action, the Examiner uses similar language in rejecting Applicant's claim 5. Both the power source and the LED light source that is disposed within the headlight housing are essential components of Applicant's invention, neither of which are claimed or shown by the Lagerway reference. Applicant's invention is not obvious in light of Lagerway, which does not disclose the use of a LED light and, more importantly, the use of any light mounted inside the small housing. The Lagerway light is mounted in a separate housing

far from the head-mounted light housing and requires an extensively long fiber optic cable from the light source. Applicant's LED light source is in the mounted housing and, therefore, provides lightweight but high-intensity light at the distal opening of the headlight. This combination is not disclosed in Lagerway. Instead, the Lagerway reference teaches a complex headlamp assembly having a condensing lens group disposed in a separate box far away from the housing mounted on the doctor's head.

Second, Applicant claims and discloses a fiber optic rod having a proximal end that is adjacent to and abutting against (or otherwise in physical contact with) the LED light source, which is clearly illustrated in Figure 2. See Applicant's application, amended claims 1 and 5, Figure 2, and the amended paragraph [26]. In Figure 2, Applicant also illustrates that the proximal end of the fiber optic rod is hemispherically concave in shape so that said fiber optic rod covers the surface of the LED light source to transmit the maximum amount of light from said LED to a distal opening of the headlight housing. See Figure 2, and new claims 11 and 16. The Lagerway reference does not disclose a fiber optic rod abutting in physical contact against a light source, nor does Lagerway describe or illustrate a fiber optic rod having a hemispherical concave proximal end portion. Moreover, the light source in Lagerway is not shown in the drawings for that reference. See Lagerway et al., column 3, lines 54-57. Thus, this novel feature of the Applicant's invention distinguishes Applicant's invention from the invention disclosed in the reference.

Finally, as illustrated in Figure 2, Applicant claims that the distal end of the fiber optic rod is both in direct optical communication (see amended claim 1) and in direct physical contact with (see new claims 10 and 15) the first collimating lens. This novel

feature is clearly and distinctly shown in Figure 2 of the current application. Column 3, lines 54-62, of Lagerway discloses a pair of adjacent optical elements that are mounted within a housing “adjacent the distal end of the fiber optic cable bundle 19.” The word “adjacent” is defined as “situated near or next.” See The Merriam-Webster Dictionary, 1998. Figure 3 of Lagerway illustrates two optical elements 42 and 44 that are situated near one another, however, said optical elements are not in physical contact with one another. Similarly, Figure 3 of Lagerway also shows a fiber optic cable bundle 19 that is situated near optical element 42 but does not communicate in physical contact with said optical element 42. Lagerway shows and describes a fiber optic cable bundle 19 that is adjacent, or situated near, to optical element 42, however, said fiber optic cable bundle terminates inside the cavity holding optical elements 42 and 44 without ever physically contacting either of those optical elements. Applicant’s invention is patentably different from the invention disclosed in Lagerway where Applicant’s fiber optic rod physically contacts a first collimating lens while Lagerway’s fiber optic cable bundle is situated merely near to (but terminating before physical contact with) the optical element 42 of that invention.

Dependent claims 2 and 4 ultimately depend upon independent claim 1, and thus, include all of the elements and limitations of independent claim 1, which are not claimed by the Lagerway reference. Therefore, the Examiner’s rejection of Applicant’s claims 1, 2, 4, and 5 under 35 U.S.C. § 103(a) cannot be sustained. Applicant respectfully requests that the Examiner withdraw this rejection and allow said claims.

**B. LEHRER**

Applicant's invention includes collimating lenses and a fiber optic rod for directing high intensity light through a distal opening of a headlight. Lehrer merely describes a simple LED light mounted within a housing and having a single lens for projecting the light, said LED light assembly being capable of being attached to a head band. Lehrer discloses no structure for high-intensity optics. In reference to Lehrer on page 2 of the current Office Action, the Examiner states, "Such an arrangement is less expensive to produce and less cumbersome for the user because it does not use fiber optic cable as taught by Lehrer (Col. 1, lines 28-30). On page 3 of the Office Action, the Examiner uses similar language in rejecting Applicant's claim 5. In discussing a prior art reference that includes fiber optics, Column 1, lines 28-30 of Lehrer states, "While this light device also works quite well, fiberoptics are quite expensive and the equipment used to generate the light output is cumbersome and expensive." The Lehrer invention does not use fiber optics. Thus, Applicant's invention is not obvious under 35 U.S.C. § 103(a), because the Lehrer reference does not teach the Applicant's invention but rather teaches away from Applicant's invention.

Lehrer teaches away from using a fiber optic rod and collimating lenses because of the expense and because of the purported cumbersome nature of fiber optic headlights. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). In considering the disclosure of the Lehrer reference,

one of ordinary skill in the art would not be led in the direction of the teachings of the Applicant's invention but would be led in direction that diverges from the path taken by the Applicant. The Federal Circuit, in an unpublished opinion, has found that one of ordinary skill in the art would not be motivated to combine prior references where one of the cited references teaches away from the combination advanced by the Examiner. In re Rudko, Civ. App. No. 98-1505 (Fed. Cir. May 14, 1999) (unpublished). Thus, the Examiner's rejection of claims 1 through 5 under 35 U.S.C. § 103(a) cannot be sustained.

## **II. REJECTION OF CLAIM 3**

Applicant respectfully traverses the Examiner's rejection of claims 1, 2, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over Lagerway et al., U.S. Patent No. 5,774,271, in view of Lehrer, U.S. Patent No. 6,604,847, and further in view of Gonser et al., U.S. Patent No. 5,003,434. As previously stated, Lehrer teaches away from using a fiber optic rod and collimating lenses because of the expense and because of the purported cumbersome nature of fiber optic headlights. Therefore, one of ordinary skill in the art would have no motivation to combine the Lehrer and Lagerway references as described by the Examiner on page 4 of the Office Action. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). In considering the disclosure of the Lehrer reference, one of ordinary skill in the art would not be led in the direction of the teachings of the Applicant's invention but would be led in direction that diverges from the path taken by the Applicant. The Federal Circuit, in an

unpublished opinion, has found that one of ordinary skill in the art would not be motivated to combine prior references where one of the cited references teaches away from the combination advanced by the Examiner. In re Rudko, Civ. App. No. 98-1505 (Fed. Cir. May 14, 1999) (unpublished).

Moreover, dependent claim 3 ultimately depends upon independent claim 1, and thus, includes all of the elements and limitations of independent claim 1, which are not claimed by the Lagerway, Lehrer, or Gonser references. Thus, the Examiner's rejection of claims 1 through 5 under 35 U.S.C. § 103(a) cannot be sustained.

### **III. ADDITIONAL ARGUMENTS WITH RESPECT TO ALL CLAIM REJECTIONS**

Neither prior art reference cited by the Examiner contains any suggestion to modify the inventions described by the references in the manner set forth by the Examiner. The Examiner has applied an "obvious to try" test to the Applicant's invention in determining whether said invention is obvious under 35 U.S.C. § 103(a).

Regarding the "obvious to try" test, the Court of Customs and Patent Appeals has previously stated:

[A]pplication of the "obvious to try" test would often deny patent protection to inventions growing out of well-planned research which is, of course, guided into those areas in which success is deemed most likely. These are, perhaps, the obvious areas to try. But resulting inventions are not necessarily obvious. Serendipity is not a prerequisite to patentability. Our view is that "obvious to try" is not a sufficiently discriminatory test.

In re Lindell, 385 F.2d 453, 455 (C.C.P.A. 1967). Therefore, the Examiner's assertion that the Applicant's invention is obvious due to the Examiner's own belief, in hindsight, that the Applicant's use of the LED light and power source was obvious to try does not

set forth a sufficiently discriminatory test upon which the Examiner may rely to reject the Applicant's claims under 35 U.S.C. § 103(a). The prior art references cited by the Examiner do not teach, disclose, or suggest the modification of a physician's surgical headlamp to include a LED light connected to a power source as a source of light as is claimed in independent claims 1 and 5 of the present application. Moreover, the references cited by the Examiner do not teach, disclose, or suggest the modification of a fiber optic rod having a proximal end abutting against a LED light source and having a distal end abutting against a first collimating lens as described in the Applicant's application and drawings. The Lagerway reference also does not teach an LED light disposed within a small housing of a headlight, while the Lehrer reference teaches away from the use of a fiber optic rod with an LED light source for use as a headlight.

In Ex parte Obukowicz, 27 U.S.P.Q. 2d 1063 (Bd. Pat. App. & Interf. 1992), the Board of Patent Appeals and Interferences stated:

[T]he specific statement by [the prior art reference] is not a suggestion [to modify the references as asserted by the Examiner]. At best, the [prior art reference] statement is but an invitation to scientists to explore a new technology that seems a promising field of experimentation. The [prior art reference] statement is of the type that gives only general guidance and is not at all specific as to the particular form of the claimed invention and how to achieve it. Such a suggestion may make an approach "obvious to try" but it does not make the invention obvious.

Invitations to explore and general guidance as to the particular form of the invention found within the prior art are insufficient grounds for determining an invention to be obvious under 35 U.S.C. § 103(a). As the Examiner states on page 2 of the Office Action, the Lagerway et al. reference does "not teach the use of the power source and the LED light

source.” Moreover, the Lehrer reference provides “only general guidance as to the particular form of the claimed invention or how to achieve it.” In re Roemer, 258 F.3d 1303, 1310-1311 (Fed Cir. 2001), citing In re O’Farrell, 853 F.2d 894, 903 (1988). The Lehrer reference does not teach, disclose, or suggest the use of a LED light in combination with a complex physician’s surgical headlight that includes a fiber optic rod disposed between and physically communicating with a collimating lens and a LED light source. The suggestion of the Lehrer reference to use a LED light as the light source for a surgical headlamp may have been obvious to try, but the suggestion of “obvious to try” does not render the Applicant’s invention obvious.

Claims 2 through 4 depend on independent claim 1 of the invention, and therefore, include all of the limitations disclosed in Applicant’s claim 1. This includes the fiber optic rod that abuts directly against the LED light source in claim 1. With respect to claim 2, the inclusion of a means for attaching the headlight housing to a head band to be worn by a surgeon would not be obvious to one skilled in the art where that means for attaching is connected to a novel and previously unknown surgical headlight system that includes the fiber optic rod abutting directly against the LED light source as disclosed in claim 1 of the invention. With respect to claim 3, the use of a LED light with a white color light temperature of 5,500 kelvins (K) would not be obvious to one skilled in the art where said LED light of 5,500 K is connected to a novel and previously unknown surgical headlight system as disclosed in claim 1.

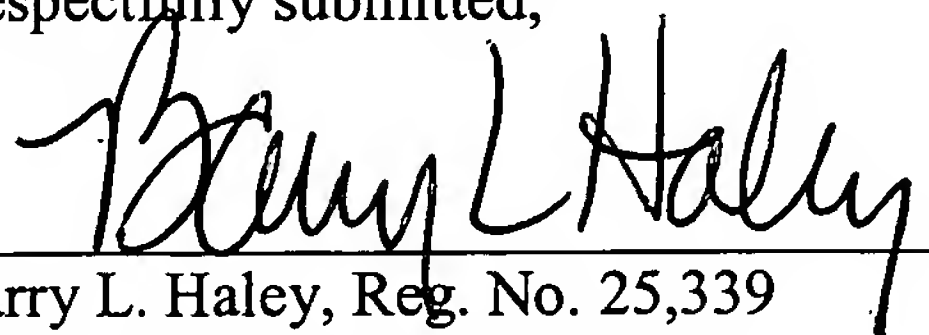
With respect to claim 4, the inclusion of a mirror mounted in the light path from the lens assembly to the housing light outlet of the headlight would not be obvious to one

skilled in the art where said mirror is used with a novel and previously unknown surgical headlight assembly that includes the fiber optic rod having direct physical contact with the LED light source as disclosed in claim 1. Because claims 2 through 4 include all of the limitations of independent claim 1, it would not have been obvious to one of ordinary skill in the art to choose the means for attaching, white color light temperature, and mirror disclosed by the Applicant in those claims as components of the headlight assembly for the simple reason that the surgical headlight system with the fiber optic rod abutting against said LED light source was unknown but for Applicant's disclosure in the application in claim 1 and Figure 2. "[O]ne cannot choose from the unknown." In re Ochiai, 71 F.3d 1565, 1570 (Fed. Cir. 1995), citing In re Mancy, 499 F.2d 1289, 1293 (C.C.P.A. 1974).

Thus, for the foregoing reasons, the Examiner's rejection of claims 1 through 5 under 35 U.S.C. § 103(a) cannot be sustained. Applicant respectfully requests the Examiner to withdraw these rejections and to enter the Amendment.

If there are any additional charges, including extension of time, please bill our Deposit Account No. 13-1130.

Respectfully submitted,



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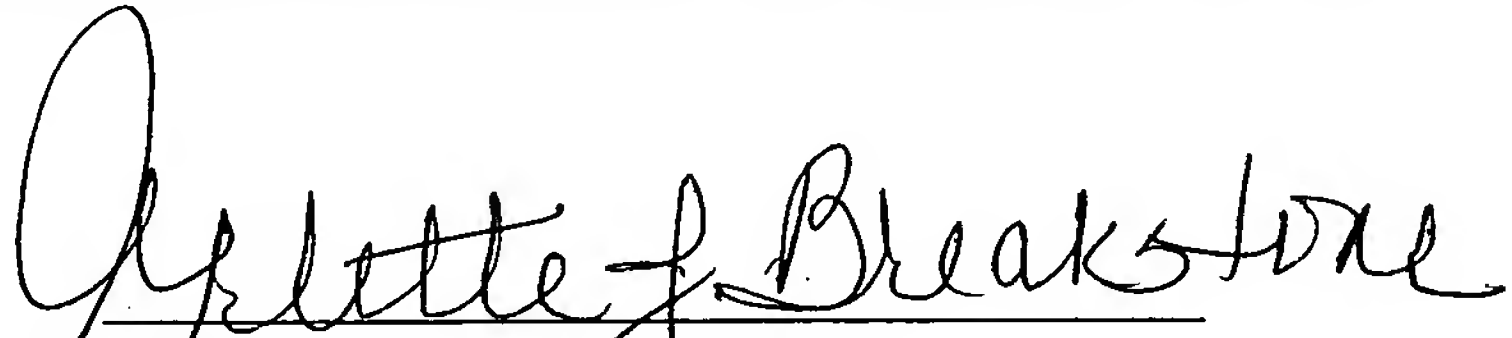
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**CERTIFICATE OF EXPRESS MAIL**

I HEREBY CERTIFY that the following correspondence: Amendment Transmittal Letter (in Duplicate); Amendment; and a Return Postcard for confirmation of receipt, is being deposited with the United States Postal Service as Express Mail No. EV 720779394 US, addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450 on this 9th day of January, 2006.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Any additional charges, including extension of time, please bill our Account No. 13-1130.

  
Arlette J. Breakstone / Paralegal

Date: January 9, 2006

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